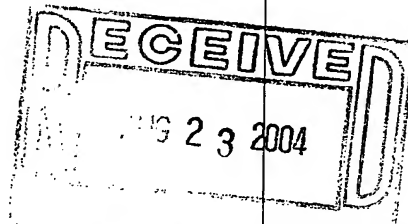


PATENT COOPERATION TREATY

From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

To:

CALDWELL, Stacey E.
MOLEX INCORPORATED
2222 Wellington Court
Lisle, IL 60532
ETATS-UNIS D'AMERIQUE



PCT

21 APR 2005

WRITTEN OPINION
(PCT Rule 66)

Date of mailing
(day/month/year)

17.08.2004

Applicant's or agent's file reference
A3-158PCT

REPLY DUE

within 2 month(s)
from the above date of mailing

International application No.
PCT/US 03/1881

International filing date (day/month/year)
08.10.2003

Priority date (day/month/year)
25.10.2002

International Patent Classification (IPC) or both national classification and IPC
H01R31/06

Applicant
MOLEX INCORPORATED et al.

DOCKET FEN 12

Case No. : A3-158PCT

1. This written opinion is the **first** drawn up by this International Preliminary Examining Authority.
2. This opinion contains indications relating to the following items:

| | | |
|------|-------------------------------------|--|
| I | <input checked="" type="checkbox"/> | Basis of the opinion |
| II | <input type="checkbox"/> | Priority |
| III | <input type="checkbox"/> | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability |
| IV | <input type="checkbox"/> | Lack of unity of invention |
| V | <input checked="" type="checkbox"/> | Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement |
| VI | <input type="checkbox"/> | Certain documents cited |
| VII | <input type="checkbox"/> | Certain defects in the international application |
| VIII | <input type="checkbox"/> | Certain observations on the international application |

Serial No. :

ITEM : Article 34 amendment

DATE DUE 10/17/04

3. The applicant is hereby **invited to reply** to this opinion.

When? See the time limit indicated above. The applicant may, before the expiration of that time limit, request this Authority to grant an extension, see Rule 66.2(d).

How? By submitting a written reply, accompanied, where appropriate, by amendments, according to Rule 66.3. For the form and the language of the amendments, see Rules 66.8 and 66.9.

Also: For an additional opportunity to submit amendments, see Rule 66.4.
For the examiner's obligation to consider amendments and/or arguments, see Rule 66.4 bis.
For an informal communication with the examiner, see Rule 66.6.

If no reply is filed, the international preliminary examination report will be established on the basis of this opinion.

4. The final date by which the international preliminary examination report must be established according to Rule 69.2 is: 25.02.2005

Name and mailing address of the international preliminary examining authority:



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Authorized Officer

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I. Basis of the opinion

1. With regard to the **elements** of the international application (*Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this opinion as "originally filed"*):

Description, Pages

1-7 as originally filed

Claims, Numbers

1-5 filed with telefax on 26.04.2004

Drawings, Sheets

1/12-12/12 as originally filed

2. With regard to the **language**, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language: , which is:

- ☐ the language of a translation furnished for the purposes of the international search (under Rule 23.1(b)).
- ☐ the language of publication of the international application (under Rule 48.3(b)).
- ☐ the language of a translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in written form.
- ☐ filed together with the international application in computer readable form.
- ☐ furnished subsequently to this Authority in written form.
- ☐ furnished subsequently to this Authority in computer readable form.
- ☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
- ☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. The amendments have resulted in the cancellation of:

- ☐ the description, pages:
- ☐ the claims, Nos.:
- ☐ the drawings, sheets:

5. ☐ This opinion has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)).

6. Additional observations, if necessary:

V. Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**1. Statement**

| | | |
|-------------------------------|--------|-----|
| Novelty (N) | Claims | |
| Inventive step (IS) | Claims | 1,2 |
| Industrial applicability (IA) | Claims | |

2. Citations and explanations**see separate sheet**

Re Item V

Reasoned statement under Rule 66.2(a)(ii) PCT with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement.

1. STATE OF THE ART

Reference is made to the following documents:

D1: US-A-5 752 857 (A.J.KNIGHTS) 19 May 1998

2. LACK OF INVENTIVE STEP

The present application does not meet the requirements of Article 33(3) PCT because the subject-matter of the claim 1 is not inventive. The reasons are the following:

Document D1, which is considered to represent the most relevant state of the art, discloses:

an adapter for coupling a smart card to a IC card connector comprising:
a two-part housing means (col. 5, lines 19-41; fig. 6, references 162,164) including an inner cavity (fig.6, reference 100) for receiving a smart card (fig. 6, reference 30), the housing means including a base housing (fig. 6, reference 162) defining a substantial portion of said inner cavity and a inner housing (fig. 6, reference 164) separate from and independent of the base housing ; and
a plurality of terminals (fig. 6A, references 92A, 170,114A) stamped and formed of conductive material, each terminal including a first contact portion (fig. 6A, reference 92A) at one end thereof for engaging an appropriate contact ((fig. 6, reference 88) on the IC card connector (fig.4, reference 82), a second contact portion (fig. 6, reference 114A) at an opposite end thereof for engaging an appropriate contact (fig. 4, reference 116) of the smart card and a mounting section (fig. 6A, reference 170) between said opposite ends, the mounting section of the terminals being press-fit into terminal-receiving passages in the inner housing.

The subject-matter of claim 1 differs from the disclosure of D1 in that:
the adapter from claim 1 is used to enable a miniature memory card to be inserted into a larger, standard memory card connector.

The disclosure of D1 is providing the same advantages as the subject-matter of claim 1, namely connecting a card of one standard to a slot for a card of another standard. The skilled person would therefore regard it as a normal option to adapt the disclosure of D1 in order to facilitate insertion of a miniature memory card in a standard memory card connector. Therefore, the subject-matter of claim 1 does not involve an inventive step [Article 33(3) PCT].

3. DEPENDENT CLAIMS

- 3.1 The additional features of claim 2 are disclosed in D1 (see fig. 6). Therefore claim 2 is also not inventive.
- 3.3 The additional features of dependent claims 3,4 and 5 are neither known from, nor rendered obvious by, the documents cited in the International Search Report.

4. MISCELLANEOUS

When a new set of claim will be drafted, it is suggested to bear in mind that:

- the independent claim should be drafted the two-part form in accordance with Rule 6.3(b) PCT, with those features known in combination from D1 being placed in the preamble [Rule 6.3(b)(i) PCT] and with the remaining features being included in the characterising part [Rule 6.3(b)(ii)PCT];
- the description should indicate D1 as a document reflecting the prior art [Rule 5.1(a)(ii) PCT];
- the description should be amended in order to disclose the invention as claimed [Rule 5.1(a)(iii) PCT] - see that no method is claimed.